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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,143	07/31/2003	Thomas F. Doyle	020475	3103
23696	7590	02/17/2009	EXAMINER	
QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121			HAYLES, ASHFORD S	
ART UNIT		PAPER NUMBER		
3687				
NOTIFICATION DATE		DELIVERY MODE		
02/17/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/633,143	<b>Applicant(s)</b> DOYLE ET AL.
	<b>Examiner</b> Ashford S. Hayles	<b>Art Unit</b> 3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 20 August 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-25 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. Amendment received on August 20, 2008 has been acknowledged. Amendment to claim 6 has been entered. Therefore, claims 1-25 are currently pending.

#### ***Response to Amendment***

2. Applicant's amendments are sufficient to overcome previous claim objections and 35 USC 103(a) rejections as set forth in the previous office action.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3, 6-7, 9-13, 16, 18-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable by Prange (2005/0086138).**

**As per Claims 1, 10 and 18,** Prange discloses an apparatus for providing separable billing services (Figure 1, Billing Calculation Center 8), comprising:

    a memory for storing an identifier, the identifier identifying a digital processing device connected to a data network, the identifier further assigned a communication type (pg.1, ¶ [0011] discusses standard information: identity of the subscriber identity module in the mobile radio terminal 3, duration of the call, tariff, roaming charge, etc., details of the service-related or private nature of the current or most recently made call are also stored in a list billing record for this subscriber 1 or for his subscriber identity module, in the billing calculation server 8); and

a processor for receiving a data packet, the data packet comprising an address, the processor for comparing the address to the identifier and for adjusting an account associated with the communication type if the address matches the identifier (pg. 1, ¶ [0011] A message representing the service-related or private nature of the current or most recently made call can be sent by the mobile radio terminal 3 as a short message SMS, MMS, etc., USSD or in another manner to an address (for example a short message center 7) of the mobile radio network 5,6, from where it is forwarded to a billing calculation server 8 of the mobile radio network to enable the monthly charges to be calculated).

Therefore Prange discloses the claimed apparatus except for a memory and a processor. Prange discloses that it is known in the art to provide a bill calculation server. Examiner takes Official Notice that it would have been well known within the art for a server to comprise a memory and a processor. Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to provide the bill calculation server of Prange with a memory storing unit for storing identifiers and a processing unit to process data packets of, in order to separate invoicing of private and service-related conversations on mobile telephones.

**As per Claims 2, 13 and 21** Prange discloses the apparatus of Claim 1, further comprising an interface for routing said data packet to a destination associated with the address (Figure 1, depicts Short Message Center 7 interfaced with Billing Calculation 8).

**As per Claims 3, 11 and 19** Prange discloses the apparatus of Claim 1, wherein the communication type comprises a business-type communication (pg.1, ¶ [0011] discusses service related call).

**As per Claims 6, 16 and 24** the apparatus of Claim 1, wherein the processor further comprising a second account, the second account associated with a second type of communication, if the address does not match the identifier (pg.1-2, ¶ [0011] discloses charge information is split in accordance with the information stored on the service-related or private nature and produces two part-invoices for service-related and private calls for the invoice for the mobile radio subscriber 1. In this case the basic subscription charge can also for example be split pro-rata or equally).

**As per Claims 7, 12 and 20** the apparatus of Claim 6, wherein the second type of communication comprises a personal-type communication (pg.1, ¶ [0011] discloses private nature calls).

The Examiner notes for examination purposes, the Examiner will take the broadest reasonable interpretation of the above underlined portion of the claims. Since the "if" statement is conditional and not necessarily performed, once the positively recited steps in the claims are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

**5. Claims 4-5, 8, 14-15, 17, 22-23 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Prange (2005/0086138) in view of Kelley (2002/0042715).**

**As per Claims 4-5 14-15 and 22-23** Prange discloses the apparatus of Claim 1.

However, Prange fails to disclose wherein the address comprises a destination and source address.

Kelley discloses wherein the address comprises a destination and source address (Figure 3, Separation process depicts Destination Phone number or URI and Originating Phone number, TCP/IP address, username or other mobile device owner-identifying attribute).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the separate invoicing of private and service-related conversations of Prange to include the destination and originating phone numbers as taught by Kelley in order to delineate responsibility for payment of billings due to use of communication devices (Abstract).

**As per Claims 8, 17 and 25** Prange discloses the apparatus of Claim 1.

However, Prange fails to disclose *wherein the data packet is not forwarded to the digital processing device if the address does not match the identifier.*

Kelley discloses wherein the data packet is not forwarded to the digital processing device if the address does not match the identifier (pg.2, ¶ [0031] discusses Keypad Separation; after completing a service transaction (e.g. a voice or data call or browsing to a URI), or before completing said transaction, which is based on the features and capabilities of the mobile device being used, the user enters one or more pre-designated keys (e.g. pressing '1' for personal or '2' for business). These additional keys are recorded by the carrier (=Service provider) and are included in the CDRS. During the separation process calls are identified as employer or employee calls by

looking up the entered key and comparing it to what the employer had specified as codes indicating either business or personal transactions).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the separate invoicing of private and service-related conversations of Prange to include the ability to filter calls that match stored identifiers as taught by Kelley in order to delineate responsibility for payment of billings due to use of communication devices (Abstract).

The Examiner notes the emphasized portion of the above claim recite a negative limitation, which define the invention in terms of what it was not, rather than pointing out the invention, therefore the emphasized portion will be given little patentable weight. Also for examination purposes, the Examiner will take the broadest reasonable interpretation of the above underlined portion of the claims. Since the "if" statement is conditional and not necessarily performed, once the positively recited steps in the claims are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

***Response to Arguments***

6. Applicant's arguments, see Remarks, filed August 20, 2008, with respect to claims 1-25 have been fully considered and are persuasive. The 35 U.S.C. 103(a) prior art rejection of Wakamatsu (2003/0144929) and Jain et al. (#6,282,274) has been withdrawn.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kotzin (2004/0259525) discusses a method for partitioning billing charges for calls handled by a wireless subscriber unit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashford S. Hayles whose telephone number is 571-270-5106. The examiner can normally be reached on Monday thru Thursday 8:30 to 4:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Gart can be reached on (571) 272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/

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Supervisory Patent Examiner, Art  
Unit 3687

/A. S. H./  
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